

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed April 5, 2005. At the time of the Office Action, Claims 1-4, 6-14, 16-24, 26-34, and 36-64 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 47, 55, and 63.

Election/Restriction

Applicant hereby elects to prosecute Claims 1-4, 6-14, 16-24, 26-34, and 36-64 at this time. The prosecution of Claims 65-70 is hereby deferred such that these claims may be pursued in a Divisional Application.

Section 103 Rejections

The Examiner rejects Claims 1, 6-11, 16-21, 26-31, and 36-40 under 35 U.S.C. §103(a), as being unpatentable over U.S. Publication No. 2002/0037744 issued to Bhatia et al. (hereinafter "*Bhatia*"). The Examiner rejects Claims 2-4, 12-14, 22-24, 32-34, 41-46, 48-54, 56-62, and 64 under 35 U.S.C. §103(a), as being unpatentable over *Bhatia* and further in view of U.S. Publication No. 2002/0065064 issued to Griffith et al. (hereinafter "*Griffith*"). These rejections are respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in

¹ See M.P.E.P. §2142-43.

combination teach, suggest, or disclose each and every claim limitation of the Independent Claims.

For example, Independent Claim 1 recites generating ... an application level signaling message associated with a network session, wherein the message is communicated to a serving node such that the serving node is made aware of session activity of the mobile unit, and determining allowability of the session, through out-of-band communications, based on a service agreement without accessing external resources.

As the Examiner readily concedes, neither *Bhatia* nor *Griffith* offer any architecture that offers these out-of-band capabilities. (See Previous Office Action: page 4.) Moreover, there is no disclosure of such signaling being used to determine the allowability of the session. Nor is there any connection between the missing signaling and a service agreement, whereby external resources are not accessed. Indeed, the Examiner, in essence, is lacking disclosure for all four of these elements, which are clearly outlined by Independent Claim 1. In addition, the Examiner failed to offer any additional reference that relates to this subject matter. Studying *Bhatia* and *Griffith* carefully confirms that such operations are not only lacking in their teachings, but such functions are not even contemplated by such configurations.

The Examiner asserts that such an element “would have been obvious to one skilled in the art.” However, such an assumption is presumptuous and devoid of sound reasoning. As a preliminary matter, the Examiner should understand why such out-of-band signaling is significant and advantageous. As highlighted throughout Applicant’s Specification, out-of-band messages are communicated between a wireless device and an agent in the serving node when the wireless device is attempting to initiate a network session. This allows the agent to verify session activity and inform the wireless device, which may then connect to the network as requested, without the payload data being inspected and the contents of the payload data being checked against user conditions for each packet message from a wireless device. Accordingly, the burden on the resources of the serving node with regard to verifying session activity is greatly reduced, which (in turn) frees those resources to accomplish other tasks.

Moreover, by providing an out-of-band signaling mechanism through the use of agent discovery messages, a wireless device and a serving node can communicate effectively with out-of-band messages. Thus, the traffic and the signaling messages do not need to be mixed,

which optimizes the flow. As a result, the serving node does not need to inspect every packet for service trigger management. This would enhance processing speeds and augment performance. (Note that proper support for this information can be found throughout the Specification (e.g. See pages 4-5.)

For all of these reasons, the choice to implement out-of-band messages is significant and, therefore, would not have been obvious to a person having ordinary skill in the art. Such an innovation is the result of considerable insight, acumen, and diligence. Hence, the Examiner's §103 analysis is untenable and, ergo, the subject matter of the pending claims is clearly allowable over *Bhatia*.

Additionally, Applicant reiterates that even if this out-of-band signaling of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Bhatia* reference or of the proposed *Bhatia-Griffith* combinations is still improper because the Examiner has not shown the required suggestion or motivation in *Bhatia* or in *Griffith*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.² Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.³

There is nothing in *Bhatia* or in *Griffith* that suggests or motivates the usage of out-of-band signaling, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁴ This is because the references fail to include the out-of-band capabilities and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that "it would have been obvious" to make the proposed

² M.P.E.P. §2143.01 (emphasis in original).

³ *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

⁴ If "common knowledge" or "well known" art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

combination because the proposed combination would be helpful is insufficient under M.P.E.P.⁵ guidelines and governing Federal Circuit case law.⁶ The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.⁷ Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”⁸ Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”⁹

It should also be noted that in the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a *prima facie* case of obviousness.

Independent Claims 11, 21, 31, 41, 49, and 57 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

⁵ See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁶ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

⁷ See M.P.E.P. §2145.

⁸ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

⁹ See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

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Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,
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